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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,846	07/24/2001	Takatoshi Nishizawa	210638US0	4818

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 5/30/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-29 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -559, taken in view of Janocha et al., substantially for the reasons set forth in paragraph No. 10 of Paper No. 10, together with the following additional observations. Applicant argues (Response, page 5, middle paragraph) that with respect to the prior art combination there is nothing in the secondary reference to overcome the teaching of EP -599 that the antistatic agent should appear only in the heat sealable resin layer, and further argues that the disclosure at column 5, lines 36-38 of the secondary reference that such elements as antistatic agents, slip agents or stabilizers may be optionally added to either the core layer and/or the top layers does not overcome the teaching of the primary reference that the antistatic agent should appear in the heat sealable layer. However, applicant's arguments overlook the critical point that although EP -599 "does not teach the presence of an interlayer between the thermoplastic resin film-layer and the heat sealable outer layer," the reference does teach the presence of interlayers in such reference structures and, more importantly, that "the same thermoplastic resin utilized in applicant's interlayer structure can comprise the thermoplastic resin film base layer material". Note again EP -599 at page 4, lines 3-7,

wherein the interlayer can be laminated to a core layer and the interlayer comprises fine inorganic particles, optionally high density polyethylene and a propylene resin, which is the same composition that can be utilized (EP -599, page 3, line 31+) as the base layer of the primary reference. Additionally, ^{note again} ~~when~~ the teachings of the secondary reference to the effect that the specific location of components such as antistatic agents as well as low molecular weight polyethylenes, polyamide resins and the like are all but a mere design choice for one of ordinary skill in the art. In summary, applicant's position overlooks the substance of the teachings which make the prior art reference combination a viable entity, and therefore the Examiner must hold the prima facie case of record to be non-rebutted. With respect to the dependent claims, these are again treated in the manner previously set forth, and although it is noted that applicant comments that "the present invention avoids defects due to resin-like stains, in contrast to in-mold labels of the type disclosed in EP -599" (Response, page 5, bottom three lines), this limitation has not been set forth in the claims, although it has been set forth in the newly presented Abstract, and the Examiner makes the observation that should further prosecution be contemplated it might prove to be a non-obvious property of the claimed genus of articles.

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3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Nishizawa et al., the issued patent from Serial No. 09/287,194 cited by applicant, as well as two references cited therein, Balaji et al., and Ohno et al.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel

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Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

July 31, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~4300~~
1700

Daniel Zirker